

## **REMARKS**

### **A. Background**

Claims 1-20 and 30-41 were pending in the application at the time of the Office Action.

Claims 1-20 and 30-41 were rejected as being anticipated and/or obvious over cited prior art.

Claims 21-29 were canceled in an earlier paper. By this response, Applicant has cancelled claim 9, amended claims 1, 3, 5, 6, 12, 30, 32-34 and 41, and added new claims 42 and 43. As such, claims 1-8, 10-20 and 30-43 are presented for the Examiner's consideration in light of the following remarks.

### **B. Proposed Amendments**

Applicant has amended claims 1, 3, 5, 6, 12, 30, 32-34 and 41, and added new claims 42 and 43 to remedy various informalities and to further clarify the invention. Support for these amendments and new claims can be found at least at Figure 2 and paragraphs [0048] and [0057] of the specification.

In view of the foregoing discussion, applicant submits that the amendments to the claims do not introduce new matter and entry thereof is respectfully requested.

### **C. Rejection on the Merits**

#### **1. Objections to the Claims**

Page 2 of the Office Action objects to claim 41 due to an informality. Applicant has amended claim 41 herein as suggested by the Examiner. As such, Applicant submits that the objection has been overcome and should be withdrawn.

2. Rejections based on 35 USC § 102

Applicant respectfully notes that a claim is anticipated under 35 U.S.C. § 102(a), (b), or (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *MPEP § 2131*.

Pages 2 and 3 of the Office Action reject claims 1-7, 9, 12-16, 18, 30-36, 38 and 41 under 35 USC § 102(b) as being anticipated by U.S. Patent No. 5,163,940 to Bourque (“*Bourque*”). Inasmuch as claim 9 has been cancelled herein, the anticipation rejection regarding that claim has been rendered moot. Regarding claims 1-7, 12-16, 18, 30-36, 38 and 41, Applicant respectfully traverses these rejections for the reasons set forth below.

As shown in Figure 2, *Bourque* discloses a surgical drill guide comprising an arcuate support beam 22 having a drill guide locator 24 mounted on one end. A drill sleeve 32 is linearly slidably disposed within drill guide locator 24 and is configured to receive and align a drill for drilling into a tibia. A proximal end of an elongated locator probe 28 is mounted to support beam 22 so as to be movable along support beam 22. See Abstract.

*Bourque* discloses that “the arcuate shape of the beam [22] assures that the [distal] end of the locator probe 28 and a drill positioned in the drill guide locator 24 will have a common point of intersection (at or adjacent point 34) regardless of the position of the locator probe 28 along the beam 22.” Col. 3, lines 47-52; see also col. 2, lines 43-46. That is, the distal end of locator probe 28 remains in generally the same location while the proximal end of locator probe 28 effectively pivots about the distal end when the proximal end is moved along support beam 22. As such, while locator probe 28 is movable along support beam 22, the second end of the locator

probe remains in relatively the same location. This allows the axis of the drill sleeve 32 to intersect locator probe 28 at the same locator probe location regardless of the rotational position of locator probe 28 relative to support beam 22.

In view of the foregoing, *Bourque* does not teach or suggest a template and a tubular guide sleeve both mounted to a brace, “the template being movable between a posterior position and an anterior position with respect to the brace; and ... the tubular guide sleeve ... having a central longitudinal axis that intersects with a first location of the template when the template is in the posterior position and intersects with a second location of the template when the template is in the anterior position, the second location being spaced apart from the first location,” as recited in amended claim 1.

Furthermore, the locator probe 28 of *Bourque* is only shown as a shaft having a bend 84, the shaft having a cross sectional height and width that are substantially equal. This is reinforced by the *Bourque* specification, which discloses the locator probe 28 as being “an elongated shaft.” Col. 4, line 24. Nowhere in *Bourque* is there any disclosure of any portion of the locator probe 28 having a plate-like shape. *Bourque* further discloses that the “shaft” shape has been chosen “in order to allow the probe to be inserted and positioned in the knee joint without contacting or being interfered with by the tibial plateau or the patella.” Col. 4, lines 24-29.

Accordingly, because *Bourque* discloses locator probe 28 being a “shaft” and because *Bourque* discloses that the probe has been designed to avoid contact with the tibial plateau, *Bourque* does not teach or suggest a template mounted to a brace, “the template comprising a base plate in the form of a low profile plate being adapted to rest on a lateral or medial facet at the proximal end of the tibia,” as recited in claim 12, or a template mounted to a brace, “the template comprising a base plate in the form of a flattened plate being adapted to rest on a

facet at the end of the bone,” as recited in claim 30, or a template mounted to a brace, “the template comprising a base plate in the form of an enlarged plate being adapted to rest on a facet at the end of the bone,” as recited in 41.

In view of the foregoing, Applicant respectfully requests that the anticipation rejection with respect to claims 1, 12, 30, and 41 be withdrawn. Claims 2-7, 13-16, 18, 31-36 and 38 variously depend from claims 1, 12 and 30 and thus incorporate the limitations thereof. As such, applicant submits that claims 2-7, 13-16, 18, 31-36 and 38 are distinguished over the cited prior art for at least the same reasons as discussed above with regard to claims 1, 12 and 30. Accordingly, Applicant respectfully requests that the anticipation rejection with respect to claims 2-7, 13-16, 18, 31-36 and 38 also be withdrawn.

3. Rejections based on 35 USC § 103

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143.

Page 3 of the Office Action rejects claims 8, 17, and 37 under 35 USC § 103(a) as being obvious over *Bourque* in view of U.S. Patent No. 4,781,182 to Purnell et al. (“*Purnell*”). *Purnell* was merely cited for allegedly teaching the use of a plurality of templates. Pages 3 and 4 of the Office Action reject claims 10, 19, and 39 under 35 USC § 103(a) as being obvious over *Bourque* in view of U.S. Patent No. 5,354,302 to Ko (“*Ko*”). *Ko* was merely cited for allegedly

teaching a plurality of teeth at the end of the guide sleeve. Page 4 of the Office Action rejects claims 11, 20, and 40 under 35 USC § 103(a) as being obvious over *Bourque* in view of U.S. Patent No. 6,120,511 to Chan (“*Chan*”). *Chan* was merely cited for allegedly teaching a tubular drill sleeve and a guide wire within the guide sleeve. Applicant respectfully traverses these rejections.

Claims 8, 10, 11, 17, 19, 20, 37, 39 and 40 variously depend from claim 1, 12 or 30, and thus incorporate the limitations thereof. As such, even if, *arguendo*, it would have been obvious to modify *Bourque* with the teachings of *Purnell*, *Ko*, and/or *Chan* in the allegedly obvious manners set forth in the Office Action, the resulting combination(s) would still not cure the deficiencies of *Bourque* with regards to claims 1, 12 and 30. Specifically, the purportedly obvious combination would still not produce a template and a tubular guide sleeve both mounted to a brace, “the template being movable between a posterior position and an anterior position with respect to the brace; and ... the tubular guide sleeve ... having a central longitudinal axis that intersects with a first location of the template when the template is in the posterior position and intersects with a second location of the template when the template is in the anterior position, the second location being spaced apart from the first location,” as recited in amended claim 1, or a template mounted to a brace, “the template comprising a base plate in the form of a low profile plate being adapted to rest on a lateral or medial facet at the proximal end of the tibia,” as recited in claim 12, or a template mounted to a brace, “the template comprising a base plate in the form of a flattened plate being adapted to rest on a facet at the end of the bone,” as recited in claim 30, or a template mounted to a brace, “the template comprising a base plate in the form of an enlarged plate being adapted to rest on a facet at the end of the bone,” as recited in 41.

As such, applicant submits that claims 8, 10, 11, 17, 19, 20, 37, 39 and 40 are distinguished over the cited art for at least the same reasons as discussed above with regard to claims 1, 12 and 30. In view of the foregoing, Applicant submits that claims 8, 10, 11, 17, 19, 20, 37, 39 and 40 are not obvious over the cited art. Accordingly, Applicant respectfully requests that the obviousness rejection with respect to claims 8, 10, 11, 17, 19, 20, 37, 39 and 40 be withdrawn.

No other objections or rejections are set forth in the Office Action.

D. New Claims

New claims 42 and 43 indirectly depend from claims 12 and 30, respectively. Applicant submits that new claims 42 and 43 are allowable for substantially the same reasons as discussed above with regard to claim 1.

E. Conclusion

Applicant notes that this response does not discuss every reason why the claims of the present application are distinguished over the cited art. Most notably, applicant submits that many if not all of the dependent claims are independently distinguishable over the cited art. Applicant has merely submitted those arguments which it considers sufficient to clearly distinguish the claims over the cited art.

In view of the foregoing, applicant respectfully requests the Examiner's reconsideration and allowance of claims 1-8, 10-20 and 30-43 as amended and presented herein.

In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Dated this 4<sup>th</sup> day of April 2007.

Respectfully submitted,

/Dana L. Tangren/ Reg # 37246

DANA L. TANGREN

Attorney for Applicant  
Registration No. 37,246  
Customer No. 022913  
Telephone No. 801.533.9800  
Fax: (801) 328-1707

DLT:saw:dfw  
W:\1344742\DFW0000021949V001.DOC